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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/763,803

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Jihua Wang

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EXAMINER

ZARE, SCOTT A

ART UNIT

PAPER NUMBER

3687

MAIL DATE

DELIVERY MODE

08/28/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/763,803	Applicant(s) WANG ET AL.	
	Examiner SCOTT A. ZARE	Art Unit 3687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-13 and 15-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-13, 15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A Non-Final Rejection was mailed on 02/12/2009 in which claims 1, 4-13, and 15-19 were rejected. Applicant submitted an Amendment accompanied with Remarks on 05/11/2009 which are now subject of this Office Action.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 4-13, 15-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, independent claims 1, 15, and 19 each contain issues which preclude the claims from patentability under 35 U.S.C. 101.

Claim 1 is directed to two distinct statutory classes (i.e., a “hybrid” claim). Specifically, while the preamble of claim 1 is directed toward a method, the body of the claim recites various structures creating a presumption that applicant is intending to claim an apparatus. 35 U.S.C. 101 only allows for a patent in one statutory class. Applicant is advised to amend the claim such that it only recites one statutory class.

In addition, under the broadest reasonable interpretation, one of ordinary skill in the art would interpret the term “computer readable medium” as including –any medium capable of storing data in a form that can be accessed by a computer–. Thus, such an interpretation does not exclude a transmission medium such as a signal or wave. A signal constitutes non-patentable subject matter. The Specification is almost entirely

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directed toward equations, and only discloses one paragraph and one figure (Fig. 4) suggesting the use of a computer for performing the method. Paragraph 49 on Pg. 14 of the Specification states:

Figure 4 is a block diagram of a computer system 200 that can be used to implement the method according to one embodiment of the invention. The system includes a user interface 202, a processor 204 that executes software that can carry out the inventive algorithm, and a memory 206 that stores data such as look-up tables, part type characteristic data, turnaround time information entered by the user, etc. The user interface 202 can be any system that allows a user to send data to and receive data from the processor 204, such as a keyboard/monitor combination, touch screen, graphical user interface, etc.

There is no mention of a “computer-readable medium” in the Specification such that one of ordinary skill in the art would know that such a medium is necessarily limited to “a physical and tangible medium.” Applicant is advised to amend the claim such that the computer readable medium is limited to a physical and tangible medium.

Claims 4-13 depend on claim 1 and acquire the same deficiencies as set forth above.

Claim 15, is directed toward a method of maintaining an optimized rotatable inventory level and as amended now identifies an apparatus (i.e., "on a computer") for performing the method. However, Applicant has failed to positively recite the steps set forth in the instructions on the medium. The computer simply has a medium including some instructions. The claim fails to positively claim the steps set forth in the instructions.

Claim 16-18 depend on claim 15 and acquire the same deficiencies as set forth above.

Claim 19 appears to be directed toward an article of manufacturer. While a computer program per se is non-statutory, a computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized is statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035. However, as currently claimed, any computer readable medium would read on the claim language because Applicant has failed to provide any functionality to the instructions, such as having them executed on a computer. If applicant were to state the preamble similar to that of *Beauregard* (53 F.3d 1583 (Fed Cir. 1995), claiming "a computer readable storage device containing a set of instructions that causes a computer to perform a process), the claim would be in compliance with 35 U.S.C. 101. Applicant is advised to amend the claims such that the computer program is claimed in a process where the computer is executing the computer program's instructions.

Furthermore, a "computer-readable medium," under its broadest reasonable interpretation could be interpreted to include a signal which is non-statutory (see rejection above in reference to claim 1). Applicant is advised to amend the claim such that the computer readable medium is limited to a physical and tangible medium.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4-13, 15-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is directed to two distinct statutory classes (i.e., a “hybrid” claim). Thus, it is unclear which statutory class of invention applicant is intending to claim. Claims 4-13 depend on claim 1 and acquire the same deficiencies as set forth above.

Claim 15, is directed toward a method of maintaining an optimized rotatable inventory level and as amended now identifies an apparatus (i.e., “on a computer”) for performing the method. However, applicant has failed to positively recite the steps set forth in the instructions on the medium. The computer simply has a medium including some instructions. It is unclear what is meant by a medium “including” instructions. For purposes of this Office action, it is presumed that applicant intended to claim that the medium actually stores instructions executed by the computer to perform the method.

Claim 16-18 depend on claim 15 and acquire the same deficiencies as set forth above.

Claim 19 appears to be directed toward an article of manufacturer. However, similarly, applicant has failed to positively recite the steps. Applicant is advised to amend the claims such that the computer program is claimed in a process where the computer is executing the computer program’s instructions, and wherein the instructions are stored on a physical and tangible computer readable medium.

Response to Arguments

Applicant's arguments, see Applicant Arguments/Remarks Made in an Amendment, received 12/15/2009, with respect to currently amended claim(s) 1, 4-13, 15-19 in regard to the previous rejections under 35 U.S.C. §101 have been fully considered but are not persuasive. Applicant arguments with respect to 35 USC §112, first paragraph are persuasive. Accordingly, the previous rejection has been withdrawn. Furthermore, Applicant has amended the claims such the previous rejections under 35 USC §112, second paragraph, are moot. However, new rejections under 35 USC §112, second paragraph, have been made in view of amendments to the claims.

Examiner's Notes

Claims 1, 4-13, 15-19 appear to be allowable over the art of record, but there remains rejections under 35 U.S.C. §101 and 35 U.S.C. §112, second paragraph.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SCOTT A. ZARE whose telephone number is (571)270-3266. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matt Gart can be reached on (571) 272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew S Gart/
Supervisory Patent Examiner, Art
Unit 3687

Scott A. Zare

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August 24, 2009